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IN THE
Supreme Court of the United States
WASHINGTON, D. C.

OCTOBER TERM, 1945

No. 1013

DR. WILLIAM HOWARD HAY FOUNDATION, INC.,
PETITIONER,

vs.

SAFETY HARBOR SANATORIUM, INC.,
RESPONDENT.

BRIEF IN SUPPORT OF PETITIONER FOR WRIT OF CERTIORARI

DR. WILLIAM HOWARD HAY FOUNDATION, INC.
By R. Wilson Evans, *President*.
605 24th Avenue North,
St. Petersburg, Florida.

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AUTHORITIES

Law of Unfair Competition and Trade Marks, 3rd edition (1929) Page 24—By Harry D. Nimms 5

Law of Unfair Competition and Trade Marks, 3rd edition (1929) Section 4, Page 8—by Harry D. Nimms 5

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OPINION

The opinion of the trial court in this case will be found in the Transcript of Record, U.S.C.C.A., Fifth Circuit, Case No. 10,664, page 84.

The opinion of the United States Circuit Court of Appeals, Fifth Circuit, is to be found in their certified record, sent from that court to your court.

JURISDICTION

The jurisdiction of your Honorable Court is founded upon Judicial Code 240 as amended by Acts of February 13, 1925, 43, Statutes 938 U.S.C.A., Title 28, Vol. 4, 347.

STATEMENT

This is an application for Writ of Certiorari for a review of the Decree of the U. S. Circuit Court of Appeals of the Fifth Circuit, affirming a decree of the U. S.

District Court for the Southern District of Florida, Tampa Division. The material facts and questions involved are set forth in the foregoing Petition.

The question for decision is: Shall a new commercial corporation, established in 1936, infringe and use the trademark and trade name of an educational, scientific, charitable, non-profit foundation, owning and having a trademark and trade name built up and established over thirty years?

Will the Constitution permit such commercial concern to use unfair trade practices and fraud on the public, to the damage of the Petitioner?

Will the Constitution protect the trademark and trade name of an educational, scientific, charitable organization with a trademark established over thirty years, under the common law, and prevent its name being filched away by a commercial concern, without power, right or authority?

Will the Constitution permit a judgment to stand in any court, where the right of trial by jury has been denied by the trial judge, and where the judgment is affirmed by the Circuit Court of Appeals without prejudice?

The Circuit Court of Appeals for the Fifth Circuit erroneously affirmed the judgment of the lower court, contrary to the rulings of your Honorable Court, and to the rulings of other circuits, as well as to the weight of the authorities. Reference is hereby made to *Geo. W. Luft Co.* v. *Zande Cosmetics Co.*, 142 Fed. 2, 536:

> "Proof of actual confusion or deception of purchasers is unnecessary to establish infringement of trade mark and unfair competition, where

similarity of names is such as to make confusion likely."

Also, *A Leshen and Sons Rope Co.* v. *Freller,* 218 F. 786:

"Fraud is the basis of unfair competition."

Smith v. *Richards,* 38 U.S. 26:

"Where a party intentionally or by design misrepresents a material fact or produces false impressions to mislead another or to entrap or cheat him or to obtain undue advantage of him there is a positive fraud."

Celluloid Mfg. Co. v. *Cellonite Mfg. Co.,* 32 Fed. 97:

Justice Bradley of the Supreme Court: "We may say generally that a similarity which would likely deceive or mislead an ordinary unsuspecting customer is obnoxious to the law. Decree must go against the defendant."

In *Lawrence Mfg. Co.* v. *Tennessee Mfg. Co.,* 138 U.S. 527:

Quote Judge Thayer: "That relief is granted. Restrain the defendants from perpetrating a fraud which injures the complainant's business and occasions him a pecuniary loss."

In *Lee* v. *Halsey,* Z R 5, Ch. App. 155:

"I quite agree that they, the Plaintiff, have no property right in the name, but the principle upon which the cases on this subject proceed, is not that there is property in the word, but that it is fraud on a person who has established a trade and has carried it on under a given name that some other person should assume the same name in such a way as to induce persons to deal with him in the belief that they were dealing with the persons who have given a reputation to that name and mark."

Howard v. *Henriques,* 3 Sand 725:

"He must not by deceitful or other practices

impose on the public and he must not by dressing himself in another man's garments and by assuming another man's name endeavor to deprive that a man of his own individuality and of the gains to which by his industry and skill he is fairly entitled."

In *Barrow* v. *Marceau,* 124 App. Div. Ny. 665.

Judge Ingraham quote: "As I understand it there is no hard and fast rule by which it can be determined when the court will interfere by injunction to prevent what is practically a fraud upon a person engaged in business by the unfair methods of competition. Each case must depend on its own facts, but where it is clearly established that an attempt is being made by one person to get the business of another by any means that invokes fraud and deceit a court of equity will protect the honest trader and restrain the dishonest one from carrying out his scheme."

Menendez v. *Holt,* 128 U.S. 514.

Opinion of Chief Justice Fuller: "The intentional use of another's trade mark is a fraud. And when the excuse is that the owner permitted such use that excuse is disposed of by affirmative action to put a stop to it. Persistence then in the use is not innocent and the wrong is a continuing one demanding restraint by judicial interposition when properly invoked."

McLean v. *Fleming,* 96 U.S. 245.

Justice Clifford Quote: "Positive proof of fraudulent intent is not required where the proof of infringement is clear as the liability of the infringer arises from the fact that he is enabled through the unwarranted use."

In *Jacobs* v. *Beacham,* 221 U.S. 263.

Justice Holmes Quote: "When the defendant has to justify using the plaintiff's trade name the burden is on him. Finally as the case presents what is fraud on its face it is more likely that the defendant is a modern advertiser than that he

has discovered the hidden formulae of the plaintiff's success. To call Beacham's Pills is to call them Plaintiff's pills. The statement that the defendant makes them does not save the fraud. That is not what the public would notice or is intended to notice and if it did its natural interpretation would be that the defendant bought out the original business and was carrying it on."

The Law of Unfair Competition and Trade Marks, 3rd Edition (1929), Page 240, by Harry D. Nimms:

> "The fact that a Corporation is an eleemosynary or charitable one and has no goods to sell, does not make money, does not take it out of the protection of the law of unfair competition. Distinct identity is just as important to such a company oftentimes as it is to a commercial company. Its financial credit, its ability to raise funds, its general reputation, the credit of those managing it and supporting it, all are at stake. Its name is filched away by some other aggregation and the two become confused in the minds of the public. New York Supreme Court on application for preliminary injunction has held that a corporation organized for purpose of gain should not be allowed to use words or names which have acquired special application by reason of the charitable nature of the Plaintiff."
>
> *Society of War of* 1812 v. *Society of War* 1812 *in New York,* 46 App. Div. N.Y. 568.

The Law of Unfair Competition and Trade Marks, Harry D. Nimms, Edition 3, 1929, Sec. 4, Page 8. In an action to protect a corporate name Judge Inch said:

> "This is an identification mark widely used that belongs to the plaintiff which plaintiff has created by expenditure of large sums of money and honest skillful management and which it is entitled to keep unless voluntarily relinquished. Theoretically and perhaps practically as well this hard earned right is as important as money in the bank. It should not be taken, even nibbled away by another, any more than should the

dollars be taken away from its bank against its protest and without right in law and equity to do so."

Hanover Milling Co. v. *Metcalf,* Supra, 240 U.S. 403, 1918.

Saxleheimer v. *Eisner and Mendelson Co.,* 179 U.S. 19.

"It is not necessary to constitute infringement that every word of a trade mark should be appropriated. It is sufficient that enough be taken to deceive the public in the purchase. Vice Chancellor Shadwell in 1857 said if a thing contained 25 parts and only one was taken, such imitation would hold those responsible who had contributed the fraud."

Yale Electric v. *Robertson,* 26 F. (2d) 972 at 974.

Judge Learned Hand Quote: "It has of recent years been recognized that a merchant may have a sufficient economic interest in the use of his mark outside of the field of his own exploitation to interposition by a court. His mark is his authentic seal, by it he vouches for the goods which bear it. It carries his name for good or ill. If another uses it he borrows the owner's reputation whose quality no longer lies within his own control. This is an injury even though the borrower does not tarnish it or divert any sales by its use. For a reputation, like a face, is the symbol of its possessor and creator and another man uses it only as a mask, and so it has become to be recognized that unless the borrower's is so foreign to owner's as to insure against any identification of the two, it is unlawful."

Peninsular Chemical Co. v. *Levison,* C.C.A. 247 F. 658.

Justice Learned Hand Quote: "Trade mark a symbol. Where a confusion of source is probably an injunction should be forthcoming. A mark is a creative function, serves as a silent salesman to attract custom. The deletion of its selling powers and the whittling away of its uniqueness constitutes a real injury for which there should be redress."

WITHOUT JURY UNCONSTITUTIONAL

A trial was had without jury, even though the Petitioner requested one. Trial court refused Petitioner trial by jury. We quote from Constitutional Limitations by Cooley, Vol. 2, page 2:

> "A constitutional provision is that the right of a trial by jury shall be secured to all and remain inviolate forever. Party is entitled to examine into qualifications and impartiality of jurors and to have the proceedings published and no condition should be imposed upon the exercise of the right that shall impart value and usefulness. The trial court is never authorized to take a case from the jury where there is legitimate evidence tending to prove the cause of action."

Article 7, Amendment to Constitution of the United States:

> "In suits at common law, where the value in controversy shall exceed $20.00, the right of trial by jury shall be preserved."

Errors of U.S.C.A.A.—5th Circuit. See Appellant's Petition for rehearing attached to typewritten statement of Petition filed in this court, also as part of certified record from U.S.C.C.A.

NOT UNIFORMITY OF DECISIONS

The decision of the U.S.C.C.A., Fifth Circuit is not in conformity with the decisions in the C.A.A. Circuits, on similar cases.

> *R. H. Macy Co. Inc.* v. *Macy Drug Stores, Inc.,* 84 Fed. 2d 387.
>
> *Mantle Lamp Co. of America* v. *Aladdin Lamp Co.* 78 Fed. 2d 426.

There is no question as to the infringement and the trial court first claimed the petitioner had proved to him he had no jurisdiction and then gave findings of

fact and conclusions of law. If he had no jurisdiction it should have been dismissed. If he had jurisdiction he should have upheld the common law of protection of Trade Marks and Trade Names.

The trial court refused a trial by jury which is unconstitutional and this case should have been tried by jury as also the trial Judge disqualified himself.

The U.S.C.C.A. should have reversed the trial court as they should have upheld the common law to protect Trade Marks and Trade Names.

ERRORS IN BOTH COURTS

IN DISTRICT COURT

(a) Refused Trial by Jury to Petitioner.

(b) Disqualified himself for trial.

(c) No consideration to 36 exhibits admitted in evidence which showed beyond a doubt the infringement, unfair trade practices, fraud, and loss to the Petitioner and damages.

(d) Improper consideration to certain forged letters of appellee not in evidence.

(e) Judgment contrary to Courts ruling at time of trial

(f) Findings of fact contradictive.

(g) Perjury of the Defendant.

(h) Lack of jurisdiction.

(i) Forgery.

(j) Collusion.

(k) Testimony of eleven witnesses and 36 ex-

hibits as well as signed documentary evidence proved the Petitioners case, but the trial Judge gave verdict to defendant who gave no testimony, produced no witnesses and no exhibits.

IN UNITED STATES CIRCUIT COURT OF APPEALS
FIFTH CIRCUIT

(a) That court labored under a misapprehension on the idea that the Petitioner had two contracts with Respondent while there was only one which was cancelled . From then on it was infringement and by forged letters.

(b) The court seemed to lose sight of all the testimony of eleven witnesses and the 36 exhibits entered in evidence by the Appellant proving his case of infringement and unfair trade practices and fraud, as well as improper trial by jury, disqualification of trial Judge, perjury of Defendant, lack of jurisdiction, forgery and collusion. While the Appellee gave no testimony, produced no evidence and no exhibits.

(c) They plainly showed prejudice of an officer of the Corporation trying the case. Note page second of their decision. This corporation is a charitable, non-profit one and allowed their President to try case who is familiar with procedure.

(d) They ask the Appellant on page 4 of their decision to show them that the findings of the trial Judge were eroneous. Thus we did in our brief to that court and besides filed a petition for a rehearing which is a matter of record with that court and a part of their record. This answered all their questions. Note also the Appellants brief in C.C.A.

(e) They acted in error on the matter of damages. Appellant showed the large amount of

money the Appellee took in as a result of this infringement. See page 83 of record in U.S.C.C.A., Fifth Circuit. They acted not in conformity to this Honourable Courts decisions but contrary to same.

See *McLean* v. *Fleming*, 96 U.S. 245.

Manhattan Medicine Co. v. *Wood*, 218 U.S. 224.

Anchor Stove and Range Co. v. *Rymer*, 97 Fed. 2d 689.

Hamilton Shoe Company v. *Wolf Bros.*, 240 U.S. 251.

Hennessey v. *Herman*, 89 Fed. Rep. 669, 670.

See page 42 of Appellants Brief in C.C.A. Fifth Circuit.

(f) They should have reversed the trial court and granted injunction. This is contrary to decisions in other C.C.A. courts and contrary to the decisions of this Honourable Court.

See *Richard Nervine* v. *Richmond*, 159 U.S. 293, 100 U.S. 82.

Yale Electric v. *Robertson*, 26 F. 2d 972.

Peninsular Chemical v. *Levison*, C.C.A. 247 F. 658.

Woolam v. *Ratcliff* I Hem and M, 259.

Schmidt v. *Brieg*, 100 Cal. 672.

Menendez v. *Holt*, 128 U.S. 514.

Uproar Co. v. *National Broadcasting Co. et al.*, 8 F. Supp. 358 at 36

(g) The Court did however affirm the Trial Courts Judgment but without prejudice. If without prejudice why not reverse the trial court and give opinion in conformity with other C.C.A. decisions in similar cases.

(h) They failed to uphold the common law of protection for the owner of a trade mark and trade name.

(i) They failed to act on the unconstitutional denial of trial by jury of the District Court.

The Petitioner, a charitable, educational, scientific, non-profit foundation, with a trade mark and a trade name established over thirty years, has a trade mark which is internationally known. The Respondent is a new corporation, formed in 1936, which is a commercial concern. It never acquired use of this name by purchase or otherwise, and has infringed since April 1937, and used the name, and perpetrated fraud on the public by representing the use of the trade mark which is not theirs and has made large income by doing so.

RESULTS OF DECISIONS

The ruling of the District Court in this case, and of the Circuit Court of Appeals, if allowed to stand, will have far-reaching effect. It will open the door to infringement by everyone, and is not upholding the common law of protection to owners of trade marks and trade names that have been built up at great expenditure of time and money, and will ruin the meaning to the public of such trade marks and trade names that have been built up and which mean the good will of such corporations. Large sums of money are involved in the building up of these trade names and trade marks, and to allow them to be filched away by concerns who are new is against the common law and the Constitution.

The question involved in this case is one of federal law which has not been, but should be, settled by this court.

We therefore, the Petitioners in this case, pray this Honorable Court for a review of the record and the decisions of the courts below in this case, and that we may be granted this Writ of Certiorari and the privilege of bringing same before your Honorable Court and that we may receive relief in this Court.

DR. WILLIAM HOWARD HAY FOUNDATION, INC.
By R. Wilson Evans, *President.*

605 24th Avenue North,
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